

S. Michael Kernan, State Bar No. 181747  
R. Paul Katrinak, State Bar No. 164057  
THE KERNAN LAW FIRM  
9663 Santa Monica Blvd., Suite 450  
Beverly Hills, California 90210  
Telephone: (310) 490-9777  
Facsimile: (310) 861-0503

Attorney for Defendants  
Alberto Lensi and  
Trans-American Films International Corporation

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA**

MARK DISALLE, an individual,  
Plaintiff

v.

ALBERTO LENSI, an individual;  
TRANS-AMERICAN FILMS  
INTERNATIONAL CORPORATION,  
a Delaware corporation; and DOES 1  
through 10,

Defendants.

Case Number: 2:22-CV-02152-SSS-  
PVCx

Assigned for all purposes to the  
Honorable Sunshine S. Sykes

**DEFENDANTS' SUR-REPLY TO  
NEW ARGUMENTS RAISED BY  
PLAINTIFF FOR THE FIRST TIME  
ON REPLY AND REPLY IN  
SUPPORT OF DEFENDANTS'  
MOTION FOR SUMMARY  
JUDGMENT**

Date: February 2, 2024  
Time: 2:00 p.m.  
Location: Courtroom 2

THE KERNAN LAW FIRM  
9663 Santa Monica Blvd., Suite 450  
Beverly Hills, California 90210  
(310) 490-9777

## TABLE OF CONTENTS

<b>I. INTRODUCTION .....</b>	<b>1</b>
<b>II. LEGAL ARGUMENT .....</b>	<b>1</b>
<b>A. Plaintiff Concedes That Plaintiff’s Complaint is Barred by the Doctrines of Laches.....</b>	<b>1</b>
<b>B. Summary Judgment Should be Granted due to no Evidence of Damages 3</b>	
<b>1. Plaintiff has waived argument on damages .....</b>	<b>3</b>
<b>2. Injunctive relief as a means to claim damages fails for at least two reasons .....</b>	<b>4</b>
<b>a. There was no evidence and not even cohesive argument to explain the irreparable injury .....</b>	<b>4</b>
<b>b. Even if Plaintiff did submit evidence of irreparable harm, it would have failed due to Plaintiff’s delay.....</b>	<b>5</b>
<b>C. Plaintiff Concedes That the Statute of Limitations Expired .....</b>	<b>6</b>
<b>D. Plaintiff Presents no Evidence to Rebut Defendants’ Estoppel Defense 7</b>	
<b>E. Plaintiff’s Individual Claims Fail due to a Lack of Evidence ....</b>	<b>7</b>
<b>1. Plaintiff has no Evidence of “Fraud” on the PTO .....</b>	<b>7</b>
<b>2. Plaintiff Concedes no Common Law Trademark/Unfair Competition .....</b>	<b>8</b>
<b>3. Plaintiff Submitted no Evidence or Argument on Dilution.....</b>	<b>8</b>
<b>F. Plaintiff’s Other Issues Raised in Reply also Fail .....</b>	<b>8</b>

1	1. Plaintiff has Exhausted all Rights he had in Bloodsport (Life	
2	Story Rights).....	8
3	2. There is no Issue with the Chain of Title .....	9
4	3. Plaintiff does not have “Priority of Use in Commerce” of the	
5	Bloodsport Trademark.....	12
6	4. Plaintiff Failed to Present Evidence to Rebut the Presumption	
7	that Defendants’ BLOODSPORT trademarks are Valid .....	13
8	5. There was no Abandonment and this Argument Fails .....	14
9		
10	III. CONCLUSION.....	15

THE KERNAN LAW FIRM  
9663 Santa Monica Blvd., Suite 450  
Beverly Hills, California 90210  
(310) 490-9777

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>Cases</b>	
<i>Amstar Corp. v. Domino's Pizza, Inc.</i> ,	
615 F.2d 252, 205 U.S.P.Q. 969 (5th Cir. 1980) .....	6
<i>B &amp; B Hardware, Inc. v. Hargis Indus., Inc.</i> ,	
575 U.S. 138 (2015).....	13
<i>Borden, Inc. v. Kraft, Inc.</i> ,	
224 U.S.P.Q. 811, 1984 WL 1458 (N.D. Ill. 1984).....	6
<i>Dep't of Parks &amp; Recreation for State of Cal. v. Bazaar Del Mundo Inc.</i> ,	
448 F.3d 1118 (9th Cir. 2006) .....	13
<i>Flexible Lifeline</i> ,	
654 F.3d .....	5
<i>Grupo Gigante SA De CV v. Dallo &amp; Co., Inc.</i> ,	
391 F.3d 1088, 73 U.S.P.Q.2d 1258 (9th Cir. 2004).....	5
<i>Herb Reed Enters., LLC v. Fla. Entm't Mgmt.</i> ,	
736 F.3d 1239 (9th Cir. 2013) .....	4, 5
<i>Iancu v. Brunetti</i> ,	
139 S. Ct. 2294 (2019).....	13
<i>Incredible Features, Inc. v. Backchina, LLC</i> ,	
2021 WL 6337194 (C.D. Cal. Dec. 16, 2021).....	3
<i>Kiva Health Brands LLC v. Kiva Brands Inc.</i> ,	
402 F. Supp. 3d 877 (N.D. Cal. 2019).....	6
<i>M2 Software, Inc. v. Viacom, Inc.</i> ,	
223 F. App'x 653 (9th Cir. 2007).....	4
<i>Marketquest Grp., Inc. v. BIC Corp.</i> ,	
316 F. Supp. 3d 1234 (S.D. Cal. 2018).....	1, 2
<i>Protech Diamond Tools, Incorporation v. Liao</i> ,	
2009 WL 1626587 (N.D. Cal. 2009) .....	5
<i>San Diego Cnty. Credit Union v. Citizens Equity First Credit Union</i> ,	
344 F. Supp. 3d 1147 (S.D. Cal. 2018).....	3
<i>Spiraledge, Inc. v. SeaWorld Entertainment, Inc.</i> ,	
109 U.S.P.Q.2d 1774, 2013 WL 3467435 (S.D. Cal. 2013) .....	5
<i>Stichting Pensioenfonds ABP v. Countrywide Fin. Corp.</i> ,	
802 F. Supp. 2d 1125 (C.D. Cal. 2011) .....	3
<i>Zacchini v. Scripps-Howard Broadcasting</i> ,	
433 U.S. 562 (1977).....	8

1 Statutes

2  
3 15 U.S.C.A. § 1115(a) ..... 14

4 Other Authorities

5 McCarthy at § 31:32 ..... 5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

THE KERNAN LAW FIRM  
9663 Santa Monica Blvd., Suite 450  
Beverly Hills, California 90210  
(310) 490-9777

## 1 I. INTRODUCTION

2 Plaintiff's Reply raises a plethora of new facts and arguments not raised in  
3 Plaintiff's Motion for Summary Judgment, each of which requires a response and  
4 allows this Sur-Reply. (*See* Motion for Leave to file a Sur-Reply/Reply). The legal  
5 and factual basis for this Sur- Reply/Reply are discussed in the Motion.

6 Here, Defendants explain why even the arguments raised by Plaintiff for the  
7 first time in Plaintiff's Reply fail. Defendants also reply, as generally permitted, to  
8 the legal reasons why summary judgment should be granted for Defendants. The first  
9 four sections explain why legally Defendants prevail as a matter of law. The fifth  
10 section explains the complete lack of evidence for each of Plaintiff's claims. The  
11 sixth section addresses the new issues raised by Plaintiff and explains why they each  
12 fail in spite of Plaintiff's sandbagging attempts to change the record on Reply.

## 13 II. LEGAL ARGUMENT

### 14 A. Plaintiff Concedes That Plaintiff's Complaint is Barred by the 15 Doctrine of Laches

16 Laches is essentially conceded by Plaintiff. Defendants could not find a  
17 single case that addressed a delay like this (30 years). Plaintiff cites one case that  
18 has no application to these facts. *See Marketquest Grp., Inc. v. BIC Corp.*, 316 F.  
19 Supp. 3d 1234, 1292–93 (S.D. Cal. 2018). Unlike that case which was filed a  
20 few months after an infringement, here, Plaintiff waited 30 years. In terms of the  
21 timing of the filing of the *Marketquest* case, the court held:

22 "In this case, the Court finds that California's four-year statute of  
23 limitations for trademark infringement governs. Marketquest timely  
24 filed suit within that period. Whereas Defendants' alleged  
infringement began to occur in December 2010, Plaintiff brought  
suit in March 2011."

25 *Id.* There was a delay in that case of three months. Here, there was a delay of 30  
26 years.

1 Here, there is also a major difference, because the filing of this case is  
 2 distantly outside the statute of limitations. When interpreting the statute of  
 3 limitations impact on laches, the court in *Marketquest* explained:

4 "In assessing delay [for laches], a court "must first decide whether  
 5 [the plaintiff] filed suit within the applicable" statute of limitations  
 6 period. (Citations.) When a plaintiff has filed suit within that time  
 7 period, "the strong presumption is that laches is  
 8 inapplicable." (Citations.) Here, because Marketquest filed its suit  
 9 within the applicable statute of limitations, its suit against  
 10 Defendants is not barred by laches".

11 *Id.* at 1293.

12 Here, it is exactly the opposite as there was a delay of 30 years,  
 13 well beyond the statute of limitations.

14 There is also massive prejudice here (which Plaintiff did not and could not  
 15 rebut). There was no prejudice at all in the *Marketquest* case from the three-  
 16 month delay. *Id.* at 1295. Three-months delay and thirty-years delay are night  
 17 and day different. Plaintiff did not even address the witnesses and documents  
 18 lost by his extraordinary delay.

19 Plaintiff completely ignores his own allegations and his testimony. He  
 20 claims Bloodsport II, III, and IV violate his rights. Specifically, Plaintiff testified  
 21 that Bloodsport II, III and IV allegedly violated his rights. (Plaintiff's SUF Nos.  
 22 4 and 5). These films are all from the 1990's. Additionally, Plaintiff's Complaint  
 23 specifically alleges as follows:

24 Notwithstanding this narrow license, after the first sequel to  
 25 *Bloodsport* was produced entitled *Bloodsport II* (1996), two  
 26 additional sequels were made: *Bloodsport III* (1997) and *Bloodsport*  
 27 *IV* (1999) using elements of the Property contrary to the license  
 28 agreement.

(Complaint, ¶ 2).

...

Further, as alleged hereinabove, Bloodsport II and III were  
unauthorized because the Limited License in the Pathe Agreement  
 (to which Defendants' succeeded) specifically reserved to Plaintiff  
 all rights in the "Bloodsport" Property other than the right to produce  
 one sequel, Bloodsport II. Defendants therefore had no right or

authority to use Plaintiffs "Bloodsport" mark beyond the single authorized sequel, Bloodsport II.

(Complaint, ¶ 63).

...

Defendants were solely authorized to use Plaintiffs "Bloodsport" mark in connection with one sequel film, *Bloodsport II*. Defendants' continuing unauthorized use in commerce of the "Bloodsport" mark dilutes and is likely to dilute the distinctiveness of Plaintiffs famous mark by eroding the identification of this mark, among the public and members of the entertainment industry, with Plaintiff, tarnishing and degrading the positive associations and prestigious connotations of the mark, and otherwise lessening the capacity of the mark to identify and distinguish Plaintiffs goods and services.

(Complaint, ¶ 83).

As evidenced by Plaintiff's judicial admissions in his Complaint, the doctrine of laches plainly bars Plaintiff's claims. Plaintiff admitted in his deposition his claims accrued more than 20 years ago.

## **B. Summary Judgment Should be Granted due to no Evidence of Damages**

### **1. Plaintiff has waived argument on damages**

Plaintiff has waived any argument on damages. *See Incredible Features, Inc. v. Backchina, LLC*, 2021 WL 6337194, at \*3 (C.D. Cal. Dec. 16, 2021); *Stichting Pensioenfond ABP v. Countrywide Fin. Corp.*, 802 F. Supp. 2d 1125, 1132 (C.D. Cal. 2011). Plaintiff has one sentence in the whole reply brief and not a single reference in his original Motion concerning damages.<sup>1</sup> In the Reply, there is one sentence about damages and it is a mere conclusion. That sentence (pertaining to the fraud on the PTO claim) is:

---

<sup>1</sup> Plaintiff cites one case, *San Diego Cnty. Credit Union v. Citizens Equity First Credit Union*, 344 F. Supp. 3d 1147, 1158 (S.D. Cal. 2018), for the proposition that if "Plaintiff has demonstrated that [if he proceeds with his film there is] a real and reasonable apprehension that [he] w[ill] be subject to an infringement action" by Defendants." First, there is no evidence demonstrating this. There is no testimony by Plaintiff that supports that position. There is no declaration from Plaintiff. There is simply no evidence submitted by Plaintiff. Second, that case has no application here as it was on a 12(b)(1) motion for lack of subject matter jurisdiction, which does not have the same standard as a motion for summary judgment. *Id.* at 1153. Additionally, evidence was provided in that case, unlike the case at hand. *Id.*



"Defendants' fraudulent statements to the USPTO resulting in TFI's registrations have just as obviously damaged DiSalle because, after DiSalle did not further extend the DiSalle/ERPFC Agreement, Defendants expressly asserted TFI's trademark registrations to encumber DiSalle's ability to secure financing/distribution for a "Bloodsport" remake."

Plaintiff provides no evidence. There is no testimony about any attempts to secure financing or distribution. Plaintiff did not even submit a declaration. Furthermore, this would be barred as speculative damages. In fact, there is no testimony by anyone as to damages, not even expert testimony. There is simply no way for this case to proceed given the lack of damages.<sup>2</sup>

**2. Injunctive relief as a means to claim damages fails for at least two reasons**

**a. There was no evidence and not even cohesive argument to explain the irreparable injury**

Injunctive relief as a method for damages for all claims but Declaratory Relief fails at the outset because Plaintiff did not even make a cohesive argument.

Moreover, Plaintiff presented no evidence of a need for an injunction. Both preliminary and permanent injunctions require that there must be "irreparable harm", and such harm *cannot* be presumed even if a likelihood of confusion is shown (which has not been shown here). *Herb Reed Enters., LLC v. Fla. Entm't Mgmt.*, 736 F.3d 1239, 1249-51 (9th Cir. 2013). The traditional four-factor test is employed by courts of equity, including "establish[ing] that remedies available at law, such as monetary damages, are inadequate to compensate' for the injury." *Id.* at 1249. In reversing the granting of a preliminary injunction, the Ninth Circuit determined that the district court

<sup>2</sup> Courts frequently grant summary judgment on damages in infringement cases where damages are unproven, remote, or speculative. *M2 Software, Inc. v. Viacom, Inc.*, 223 F. App'x 653, 655 (9th Cir. 2007); *AAA of N. Cal.*, 2019 U.S. Dist. LEXIS 47394 at \*81-82; *Blau*, 2003 U.S. Dist. LEXIS 27432 at \*9.

1 “abused its discretion by relying on “unsupported and conclusory statements  
 2 regarding harm [plaintiff] *might* suffer.” *Id.* at 1250. Additionally, the Ninth  
 3 Circuit plainly stated the new requirements for irreparable harm as follows:

4 Gone are the days when “[o]nce the plaintiff in an infringement action  
 5 has established a likelihood of confusion, it is ordinarily presumed  
 6 that the plaintiff will suffer irreparable harm if injunctive relief does  
 7 not issue.” (citation.) This approach collapses the likelihood of  
 8 success and the irreparable harm factors. Those seeking injunctive  
 9 relief must proffer evidence sufficient to establish a likelihood of  
 irreparable harm. As in *Flexible Lifeline*, 654 F.3d at 1000, the fact  
 that the “district court made no factual findings that would support a  
 likelihood of irreparable harm,” while not necessarily establishing a  
 lack of irreparable harm, leads us to reverse the preliminary injunction  
 and remand to the district court.

10 *Id.* at 1250 – 51. Here, there is simply no evidence of irreparable harm. Plaintiff  
 11 has offered no proof of loss of business, loss of customer goodwill, or any other  
 12 actual injury. Plaintiff does not even have an expert, which is typically how this  
 13 is proven. This is fatal to Plaintiff’s claims.

14 **b. Even if Plaintiff did submit evidence of irreparable harm, it**  
 15 **would have failed due to Plaintiff’s delay**

16 The delay here in seeking relief also prevents the required irreparable  
 17 injury necessary for injunctive relief. *Grupo Gigante SA De CV v. Dallo & Co.,*  
 18 *Inc.*, 391 F.3d 1088, 1102, 73 U.S.P.Q.2d 1258, 1267 (9th Cir. 2004) (Holding  
 19 that the delay means Plaintiff is estopped or barred by laches from claiming  
 20 injunctive relief); See also McCarthy at § 31:32 (Delay negates irreparable  
 21 harm). In fact, the Ninth Circuit has consistently held that this type of delay bars  
 22 the required “irreparable injury” needed for injunctive relief. *Protech Diamond*  
 23 *Tools, Incorporation v. Liao*, 2009 WL 1626587 (N.D. Cal. 2009) (After almost  
 24 twenty-four months to sue, and four more months to move for a preliminary  
 25 injunction, which was denied, court noting that: “That delay alone is sufficient to  
 26 undermine Plaintiff’s claim of immediate, irreparable harm.”); *Spiraledge, Inc. v.*  
 27 *SeaWorld Entertainment, Inc.*, 109 U.S.P.Q.2d 1774, 1779, 2013 WL 3467435  
 28 (S.D. Cal. 2013) (Denying preliminary injunction because 13-month delay

negated irreparable injury.); *Kiva Health Brands LLC v. Kiva Brands Inc.*, 402 F. Supp. 3d 877, 897 (N.D. Cal. 2019) later proceedings 2020 WL 759409, \*9 (N.D. Cal. 2020) (Four-year delay in seeking preliminary injunction supports lack of irreparable injury; preliminary injunction denied.)

"Even a few weeks' delay in filing suit may, under the proper set of facts, speak louder than plaintiff's legal arguments claiming an urgent need for a prompt injunction to remedy an allegedly irreparable injury occurring to plaintiff's trademark. For example, the federal court in Chicago said that a six-month delay in suing for false advertising 'speaks volumes about whether a plaintiff is being irreparably injured.'" *Borden, Inc. v. Kraft, Inc.*, 224 U.S.P.Q. 811, 822, 1984 WL 1458 (N.D. Ill. 1984). Another court explained that a trademark owner that strongly believed his customers were being deceived would hardly have remained idle for such an extended period of time (10 years in that case). *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 205 U.S.P.Q. 969 (5th Cir. 1980), cert. denied, 449 U.S. 899, 66 L. Ed. 2d 129, 101 S. Ct. 268, 208 U.S.P.Q. 464 (1980) (judgment for plaintiff reversed). Here, Plaintiff unreasonably delayed for thirty years precluding injunctive relief.<sup>3</sup>

### **C. Plaintiff Concedes That the Statute of Limitations Expired**

Despite Plaintiff's own deposition testimony, under penalty of perjury, that Bloodsport II, III and IV used elements of Bloodsport and "violated" his rights, Plaintiff offers no evidence in his Reply, only argument. There is no declaration from Plaintiff attempting to clarify his deposition testimony that his rights were violated. Plaintiff does not even attempt to explain why he waited for over 30 years to assert an ownership claim in Bloodsport. The statute of limitations plainly bars Plaintiff's claim of alleged ownership in Bloodsport.

---

<sup>3</sup> The cases finding a lack of irreparable injury are separate from and in addition to the laches issues in the preceding section, which highlights the multitude of issues Plaintiff has here with his 30-year delay.

**D. Plaintiff Presents no Evidence to Rebut Defendants’ Estoppel Defense**

Plaintiff presents no evidence to rebut Defendants’ estoppel defense, and merely presents conclusions. There is no declaration from Plaintiff or anyone else to rebut Defendants’ estoppel defense. Therefore, Defendants are entitled to summary judgment on this as well.<sup>4</sup>

**E. Plaintiff’s Individual Claims Fail due to a Lack of Evidence**

**1. Plaintiff has no Evidence of “Fraud” on the PTO**

Plaintiff presents no evidence, let alone the clear and convincing evidence for his claim of fraud on the PTO. Plaintiff’s entire claim is based on Defendants use of screenshots from the original Bloodsport, which Defendants had the right to do for purposes of Defendants’ trademark applications. MGM retained only the right to distribute the original Bloodsport film for its film library. MGM gave all other rights to the original Bloodsport film in any media (including applying for a trademark) to Defendants’ predecessor.

Defendants’ evidence in opposition established that there was no fraud on the PTO and all filings with the PTO were proper and done in good faith. Regardless, the issue with the screenshots from the first Bloodsport film are nonsense. This claim requires clear and convincing evidence of a subjective intent to defraud. Defendants and he lawyer that filed the application must have known that there was fraud, and did it anyway. Here, putting aside the fact that Defendants had all the rights to apply for a trademark, there is an additional reason that there was no fraud. It is well settled there are no trademark rights in a single film, and trademark rights require a series of films, as noted below. Thus, even if MGM kept certain rights, it did not have any trademark right (neither did Plaintiff) and the viability of a trademark only arose

---

<sup>4</sup> Plaintiff makes one throw away statement about “unclean hands.” Without any argument or evidence to establish alleged unclean hands. This one sentence argument should be disregarded by the Court.

1 when the subsequent series of films were created. Using the screenshots was not to  
 2 show that there was a trademark right in the first film (there cannot be one) but to  
 3 show the series of films. In any case, Defendants and the lawyer who filed the  
 4 documents with the PTO certainly did not have a subjective intent to defraud because  
 5 Defendants and she correctly believed that there can be no trademark rights in a  
 6 single film. Plaintiff certainly has presented no evidence that she, a former PTO  
 7 examiner, ever intended to defraud the PTO. Therefore, Defendants are entitled to  
 8 summary judgment on this claim as well.

9 **2. Plaintiff Concedes no Common Law Trademark/Unfair**  
 10 **Competition**

11 Plaintiff presented no evidence for his alleged common law trademark/unfair  
 12 competition claim. Plaintiff makes a convoluted argument claiming that MGM owns  
 13 the rights to Bloodsport; however, those rights are limited solely to the distribution of  
 14 the picture Bloodsport that was produced and distributed in commerce by Cannon.  
 15 All other rights associated with the film (including the trademark rights) owned by  
 16 Cannon were assigned to Defendants' predecessor. Plaintiff simply has no rights in  
 17 Bloodsport, while Defendants do.

18 **3. Plaintiff Submitted no Evidence or Argument on Dilution**

19 Plaintiff submitted no evidence concerning Plaintiff's claim for Trademark  
 20 Dilution, so Defendants' Motion should be granted on this cause of action.

21 **F. Plaintiff's Other Issues Raised in Reply also Fail**

22 **1. Plaintiff has Exhausted all Rights he had in Bloodsport (Life**  
 23 **Story Rights)**

24 There are several reasons life rights are significant contrary to what  
 25 Plaintiff claims. First, in California (where Dux is a resident) there is a right of  
 26 publicity, which is the right to make money off one's name and likeness. This  
 27 has also been upheld by the U.S. Supreme Court in the only case where the high  
 28 court has addressed the right of publicity. *Zacchini v. Scripps-Howard*

1 *Broadcasting*, 433 U.S. 562, 576 (1977) (Holding there was a right of plaintiff to  
 2 make revenue off his human cannonball act). Second, life rights are important so  
 3 as not to defame the subject of a film, or invade his privacy. In terms of privacy,  
 4 California has a claim for false light invasion of privacy that would be directly  
 5 applicable, because a claim is actionable under that tort if you say a person did  
 6 something, which in actual fact, they did not do.<sup>5</sup>

## 7 **2. There is no Issue with the Chain of Title**

8 Plaintiff's Motion did not raise any issues concerning the chain of title and  
 9 did not contest the chain of title. Plaintiff's Motion conceded the chain of title  
 10 was valid. At no time did Plaintiff argue that the trademark was not valid  
 11 because of the chain of title, and this argument lacks merit. Concerning the chain  
 12 of title, it is important to note what was retained by Metro-Goldwyn-Mayer Inc.  
 13 ("MGM"). MGM has a library of films containing everything from *Bloodsport* to  
 14 James Bond. In its option to Plaintiff's company Pyramid Entertainment, Inc.,  
 15 MGM retained ownership of only the actual film itself, and specifically, the right  
 16 to "exhibit, distribute, and otherwise exploit only the Picture itself in any and all  
 17 media..." See Dkt. 79-12 (Exhibit "K" to the November 10<sup>th</sup> Kernan Declaration  
 18 ("First Kernan Decl.")), ¶ 1(a)-(b) (emphasis added). Aside from these limited  
 19 rights, MGM assigned all other rights relating to *Bloodsport* (including for  
 20 purposes of obtaining a trademark).<sup>6</sup> *Id.*

21  
 22 <sup>5</sup> Plaintiff's two misquoted treatises do not stand for the proposition that life rights are  
 23 meaningless, as claimed. Rather, the misquote from Professor McCarthy's Trademark treatise  
 24 (which has nothing to do with life rights or entertainment law) simply does not apply when  
 25 they are making a moving and is out of context. The fact is that there are some instances  
 26 where the First Amendment allows you to tell the story (mostly when the person is a public  
 figure or where the entire story is already in the public domain), but none of that would apply  
 to Dux. In fact, the US Supreme Court specifically rejected the broad application of the First  
 Amendment that Plaintiff misleadingly argues in the *Zachinni* case.

27 <sup>6</sup> Concerning the MGM Option Agreement, the grant of rights specifically states as  
 follows:

28 All motion picture, television and allied, ancillary, subsidiary and incidental  
 rights in and to one or more motion picture prequels, sequels, remakes and/or



1 Upon execution of the MGM option in 1993, these rights (including those for  
 2 the purposes of obtaining a trademark) were transferred to Transcontinental Cinema  
 3 Group, Inc., a fact which Plaintiff does not dispute. *See* Dkt. 82-1 (Plaintiff's  
 4 Statement of Genuine Disputes of Material Fact), ¶¶ 43 and 44. These rights were  
 5 then assigned to Defendants' predecessor, FM Entertainment International (II) N.V.  
 6 ("FM Entertainment"):

7 (D) ... Accordingly, for good and valuable consideration, . . . **hereby**  
 8 **irrevocably grant, sell, transfer, convey and assign exclusively to**  
**F.M.,** in perpetuity and throughout the universe all of the following:

9 1. All of Grantor's and all of Transcontinental's right, title and  
 10 interest, whatsoever, in and to the motion picture currently entitled  
 11 "BLOODSPORT II" and all rights therein whatsoever, (the "Picture"),  
 12 and all other motion picture projects based upon the motion picture  
 13 "**Bloodsport**" described in subparagraph 1(e) below, and/or the Picture,  
 14 now held or hereafter acquired, including but not limited to:

15 (a) any and all rights acquired by Grantor and Transcontinental (or  
 16 any of them) **pursuant to that certain Option Agreement ("Option**  
 17 **Agreement") dated as of December 9, 1992 between Pyramid**  
 18 **Entertainment, Inc. and Metro-Goldwyn-Mayer, Inc.** (as successor-  
 19 in-interest to Pathe Entertainment, Inc.), including without limitation,  
 20 all rights acquired by virtue of the exercise of the option contained in  
 21 such Option Agreement;

22 *See* Dkt. 79-12 (Exhibit "M" to First Kernan Decl.), p. LENS1 0136-0137 ¶D,  
 23 ¶1(a) (emphasis added).

24 Plaintiff also attempts to retroactively alter the undisputed factual record  
 25 by stating that Trans-American and various other companies "purported to assign  
 26 their rights" to Jet-Set Aviation, Ltd. ("Jet Set"). Dkt. 82 (Plaintiff's Reply Brief)  
 27 § II(G), p. 13. However, in support of his Motion for Summary Judgment,  
 28 Plaintiff's Statement of Uncontroverted Facts states that Trans-American and FM

other productions based, in whole or in part, on the motion picture starring Jean-  
 Clause Van Damme entitled "BLOODSPORT" ("Picture") and the screenplay  
 currently entitled "BLOODSPORT II" written by Jeff Schechter, including,  
 without limitation, the right to exhibit, distribute and/or otherwise exploit any or  
 all of the foregoing in any and all media, whether now known or hereafter  
 devised, throughout the world, in perpetuity. . . .

*See* Dkt. 79-12

1 Entertainment **did** assign their rights to Jet Set, and cites to the same July 3, 2001  
 2 agreement he now seeks to undermine. Dkt. 77-1 (Plaintiff's Statement of  
 3 Uncontroverted Facts) ¶ 23.

4 Plaintiff's next alleged "gap" in the chain-of-title, which is that Jet Set  
 5 assigned its rights to Trans-American Films, Ltd. rather than to Defendant Trans-  
 6 American, misrepresents the content of the agreements and trademark records at  
 7 issue. First, the various iterations of the name "Trans-American" are not  
 8 "different companies" and "separate judicial entities" as Plaintiff misleadingly  
 9 claims. Dkt. 82 (Plaintiff's Reply Brief) § II(G) p. 14.<sup>7</sup>

10 Plaintiff then seeks to further muddy the waters by stating that  
 11 "Defendants' failed to include an assignment of any Bloodsport assets from [the  
 12 Cayman Islands entity] to [Defendant Trans-American]. Dkt. 82 (Plaintiff's  
 13 Reply Brief) § II(G) p. 14, fn. 5. However, the Declaration of Teresa Lee in  
 14 Support of Defendants' Opposition (the "Lee Declaration") clearly states that the  
 15 Cayman Islands entity was converted to a Delaware corporation, Defendant  
 16 Trans-American. Dkt. 79-45 (Lee Declaration), ¶ 27. This fact is undisputed, as  
 17 publicly available PTO records show that the Cayman Islands entity "Trans-  
 18

19 <sup>7</sup> The record shows that at the time of the rights assignments at issue, there was only one legal  
 20 entity doing business under variations of the name "Trans-American":

21 Option/Purchase Agreement (the "Agreement"), dated as of March 24, 2010,  
 22 between Edward R. Pressman Film Corporation ("Purchaser") on one hand and  
 23 **Trans-American Films International, a Cayman Islands company, doing**  
 24 **business as Trans-American Films, Inc., Trans American-Films, Ltd., Trans**  
 25 **American Film, Ltd., and any and all other names by which said entity would**  
 26 **be known ( collectively, "Trans American")** and Bloodsport New Beginning  
 27 LLC ("BNB") on the other hand with respect to the motion picture project currently  
 28 entitled "Bloodsport" which is to be a sequel of the Prior Pictures ( as such term is  
 defined below). Trans American and BNB shall be collectively referred to herein as  
 "Owner."

Dkt. 79-19 (Exhibit "S" to the First Kernan Decl.), p. 1 (emphasis added). Although Plaintiff  
 seeks to mislead as to the business names used in each agreement, the record unambiguously  
 shows that Jet Set transferred the rights at issue to a single Cayman Islands entity known by  
 multiple "dba" names, including "Trans-American Films, Ltd" and "Trans-American Films  
 International." See Dkt. 79-18 (Exhibit "R" to the First Kernan Decl.).



American Films International” (which properly applied for various BLOODSPORT trademarks) was domesticated and converted into Defendant Trans-American, a Delaware Corporation, on October 9, 2014 (a fact which the PTO was made aware of on May 10, 2021). *See* Defendants’ Request for Judicial Notice filed concurrently, Ex. “A”.

Plaintiff seeks to use the complexity of the chain of title to attempt to create confusion, even though Plaintiff conceded in his original Motion that there was no issue with the chain of title. The fact that the chain of title is complex does not mean that it is unclear. Plaintiff’s alleged “gaps” in the chain of title are simply a red herring to confuse the Court, and are easily clarified. To summarize, (1) MGM only retained limited ownership of the actual *Bloodsport* film, and sold all other rights via the 1992 MGM option, (2) the rights under the MGM option were first transferred to Transcontinental Cinema Group, LLC, and then to FM Entertainment, (3) FM Entertainment later assigned its rights to Jet Set, (4) Jet Set later assigned its rights to Trans-American Films, Ltd., a Cayman Islands entity doing business under various names including “Trans-American Films International,” (5) the Cayman Islands entity properly applied for various BLOODSPORT trademarks, and (6) the Cayman Islands entity was domesticated and converted to a Delaware Corporation (Defendant Trans-American).

### **3. Plaintiff does not have “Priority of Use in Commerce” of the Bloodsport Trademark**

Plaintiff’s argument for priority of use has so many holes it is difficult to know where to begin. First, Plaintiff had no use in commerce. He had only a script. It is well settled that the title of a book or script cannot be a trademark, unless there is a series.<sup>8</sup> Plaintiff had no series - he had one script. Second,

<sup>8</sup> But, it is important to note that the only case that Plaintiff could locate in the thousands of cases holding that one film cannot be trademarked is the “Top Gun” case, and in that case, it was not just one film. They were massive licensing businesses going on in addition to the film.

1 Plaintiff gave away all the rights. Third, Plaintiff never used the script in  
 2 commerce. He never distributed his script to the public. There is no evidence of  
 3 public distribution of his script.

4 The only case Plaintiff cites in reply on priority of use, *Dep't of Parks &*  
 5 *Recreation for State of Cal. v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1126 (9<sup>th</sup>  
 6 Cir. 2006), does not support Plaintiff's arguments. In fact, it helps Defendants.  
 7 That case plainly explained that there must be a:

8 **“[u]se in a way sufficiently public to identify or distinguish the**  
 9 **marked goods in an appropriate segment of the public mind as**  
 10 **those of the adopter of the mark.”** (Citation.) The State, however,  
 11 offers no evidence tending to show that it adopted and commercially  
 12 used the marks CASA DE PICO and CASA DE BANDINI “in a way  
 13 sufficiently public to identify or distinguish” its recreational and  
 14 tourism services **“in an appropriate segment of the public mind”**  
 15 as activities conducted by the State.

16 *Id.* at 1126 (Emphasis added). Here, it is undisputed that the first film was put  
 17 into commerce by Cannon (not Plaintiff) and the public identify the first film and  
 18 the name Bloodsport with Cannon, Defendants' predecessor in interest. The  
 19 latter films, Bloodsport II, III, and IV were all produced and distributed in the  
 20 market by Defendants' predecessor entities, not Plaintiff. Like the State in *Dep't*  
 21 *of Parks & Recreation for State of Cal.*, Plaintiff has presented no evidence of  
 22 priority of use at all. In fact, he has not even had anyone testify that his script  
 23 went to anyone but Cannon.

24 **4. Plaintiff Failed to Present Evidence to Rebut the**  
 25 **Presumption that Defendants' BLOODSPORT trademarks**  
 26 **are Valid**

27 Defendants' properly registered BLOODSPORT trademarks give  
 28 Defendants many legal benefits and protections. *See Iancu v. Brunetti*, 139 S. Ct.  
 2294, 2297 (2019); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138,  
 142 (2015). Indeed, Defendants' trademark registrations constitute “prima facie  
 evidence of the validity of the registered mark and of the registration of the mark,

1 of [Defendants'] ownership of the mark, and of [Defendants'] exclusive right to  
2 use the registered mark in commerce." 15 U.S.C.A. § 1115(a).

3 Here, Plaintiff has provided no evidence that Defendants' BLOODSPORT  
4 trademarks are not valid and failed to address or rebut the presumption that  
5 Defendants' BLOODSPORT marks are valid. Therefore, Defendants are entitled  
6 to Summary Judgment.

### 7 **5. There was no Abandonment and this Argument Fails**

8 The word "abandonment" does not appear in Plaintiff's  
9 complaint. Plaintiff has made no affirmative claim or affirmative defense for  
10 "abandonment," so he cannot generate it now. Rather, he has made judicial  
11 admissions that there is, in fact, a continued use in commerce, so he cannot take a  
12 contradictory position. Paragraph 66 of his complaint states:

13 "Defendants' unauthorized registration and use in commerce of  
14 Plaintiff's "Bloodsport" mark in connection with the production,  
15 distribution, advertising, promotion, and offering for sale of films is  
16 likely, if not certain, to cause confusion, mistake, or deception as to  
the affiliation or connection of Defendants with Plaintiff and/or  
Plaintiffs licensees as to the origin, sponsorship, association, or  
approval of Defendants' infringing films."

17 (Complaint, ¶ 66).<sup>9</sup>

18 In any case, Plaintiff submitted no evidence, nor any uncontroverted facts  
19 concerning "abandonment." Plaintiff would need to submit to the Court all of the  
20 documents from the PTO. Defendants' Opposition documents certainly address  
21 abandonment. The documents filed with the PTO attached to the Lee declaration  
22 and the Lee Declaration itself presents evidence of the use at issue filed with the  
23 PTO. In addition to all the PTO documents attached to the Lee Declaration, there  
24 are two statements of use filed with the PTO. One statement of use was filed on  
25 November 16, 2018, which was accepted by the PTO. (Lee Decl., ¶ 24, Ex.

26  
27 <sup>9</sup> Additionally, Paragraph 82 states Defendants are "continuing [our] unauthorized use  
28 in commerce of the "Bloodsport" mark [that] dilutes ... Plaintiff's mark". (See also Paragraph 87.)

1 “Y”). Additionally, another statement of use was filed on December 7, 2021,  
2 which was accepted by the PTO. (Lee Decl., ¶ 28, Ex. “BB”). The statements of  
3 use allege use in commerce of Trans-American’s mark since its 2015 and 2019  
4 registrations. There is simply no basis to claim abandonment and this evidence  
5 was submitted in opposition. Defendants have submitted evidence in support of  
6 their Opposition and Motion for Summary Judgment, while Plaintiff has  
7 submitted no evidence, just argument and opinions of Plaintiff and his counsel.

### 8 **III. CONCLUSION**

9 For the foregoing reasons, summary judgment and/or partial summary  
10 judgment should be granted in favor of Defendants on all of Plaintiff’s causes of  
11 action, and Plaintiff’s action should be dismissed with prejudice.

12  
13 Dated: January 5, 2024

THE KERNAN LAW FIRM

14  
15 By: /s/ S. Michael Kernan  
S. Michael Kernan

16 Attorney for Defendants  
17 Alberto Lensi and Trans-American  
18 Films International Corporation  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CERTIFICATION OF WORD COUNT**

I HEREBY CERTIFY that this brief contains less than 6,000 words, which complies with the word limit set by the Court's Order dated October 25, 2023. Counsel relies on the word count of the word processing program used to prepare this brief.

Dated: January 5, 2024

THE KERNAN LAW FIRM

By: /s/ S. Michael Kernan

S. Michael Kernan

Attorneys for Defendants

Alberto Lensi and Trans-American  
Films International Corporation

THE KERNAN LAW FIRM  
9663 Santa Monica Blvd., Suite 450  
Beverly Hills, California 90210  
(310) 490-9777

**PROOF OF SERVICE**

STATE OF CALIFORNIA  
COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California; I am over the age of 18 and not a party to the within action; my business address is 9663 Santa Monica Boulevard, Suite 450, Beverly Hills, California 90210.

On January 5, 2024, I served the foregoing document(s) described as:

**DEFENDANTS' SUR-REPLY TO NEW ARGUMENTS RAISED BY  
PLAINTIFF FOR THE FIRST TIME ON REPLY AND REPLY IN  
SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY  
JUDGMENT**

on the interested parties to this action as follows:

X (BY ECF SERVICE) I caused such documents to be delivered via electronic ECF through the Court's system to counsel as follows;

MarcToberoff,  
[mtoberoff@toberoffandassociates.com](mailto:mtoberoff@toberoffandassociates.com)  
TOBEROFF & ASSOCIATES, P.C.  
23823 Malibu Road, Suite 50-363  
Malibu, CA 90265

X (Federal) I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made. I declare under penalty of perjury under the laws of the United States that the above is true and correct.

Executed January 5, 2024, at Los Angeles, California.

/s/ R. Paul Katrinak  
R. Paul Katrinak